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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,253	02/13/2001	Takumi Hasegawa	Q63086	8082

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SUGHRUE, MION, ZINN, MACPEAK & SEAS
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Washington, DC 20037

EXAMINER

DAY, HERNG DER

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/781,253		HASEGAWA, TAKUMI	
	Examiner		Art Unit	
	Herng-der Day		2128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006 and 17 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11,13-17 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-11,13-17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's Amendment ("Amendment") to Office Action dated October 19, 2005, mailed January 19, 2006, and Applicant's RCE to Advisory Action dated February 6, 2006, mailed February 17, 2006.

1-1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 19, 2006, has been entered.

1-2. Claims 1, 11, and 17 have been amended. Claims 3, 12, and 18 have been cancelled. Claims 1, 2, 4-11, 13-17, and 19-26 are pending.

1-3. Claims 1, 2, 4-11, 13-17, and 19-26 have been examined and rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4, 9, 11, 17, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999.

Art Unit: 2128

3-1. Regarding claim 1, Berger et al. disclose a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

correction data receiving means for receiving and storing correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

design assisting means for reflecting said correction data (coordinate location, column 8, lines 6-9) received by said correction data receiving means on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

Wherein said design data publicizing means including

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52).

Art Unit: 2128

3-2. Regarding claim 2, Berger et al. further disclose wherein said design data is three-dimensional data (for example, 3D bag, Fig. 7).

3-3. Regarding claim 4, Berger et al. further disclose wherein said design data publicizing means including

public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52), and wherein

said editing program file enables editing of three-dimensional data (for example, 3D bag, Fig. 7).

3-4. Regarding claim 9, Berger et al. further disclose wherein said design data publicizing processing unit including

information entry selecting means allowing a user to select either information entry in the form of a menu or transfer of said public design data and an editing program file (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52).

3-5. Regarding claim 11, Berger et al. disclose a user's request reflecting design method of timely and accurately reflecting users' requests on a product, comprising the steps of:

Art Unit: 2128

publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47);

receiving correction data as said design data corrected by a user through said computer network (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9); and

reflecting said correction data received on product design (to maintain its relative location on the bag when reviewed, column 8, lines 6-9),

wherein said design data publicizing step including the step of

in response to a request from a terminal connected to said computer network, transferring public design data prepared in advance to be publicized among said design data and an editing program file for editing said public design data to said terminal (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52).

3-6. Regarding claim 17, Berger et al. disclose a server of a user's request reflecting design system for timely and accurately reflecting users' requests on a product, comprising:

design data publicizing means for publicizing design data to users through a computer network (the on-line catalog, accessed by consulting the catalog link on the screen, column 6, lines 39-47); and

correction data receiving means for receiving correction data as said design data corrected by a user through said computer network and storing said correction data (the selected GIF file, in its finalized location within the JPEG bag image file are downloaded to the supplier/system operator for storage, column 8, lines 2-9) so as to be usable by design assisting

Art Unit: 2128

means for reflecting said correction data on product design (to maintain its relative location on the bag when reviewed, column 8, lines 2-9),

Wherein said design data publicizing means including
public design data prepared in advance to be publicized among said design data (the stored graphics (button 608) to be listed, column 6, lines 48-52),

an editing program file for editing said public design data (the web site is provided as one or more Java 'applets' for operation with a Java-compatible web browser on the client's local computer, column 4, lines 36-42), and

a design data publicizing processing unit (server 116, Fig. 1) responsive to a request from a terminal connected to said computer network (By clicking both buttons 606 and 608, column 6, lines 48-52) for transferring said public design data and said editing program file to said terminal (the screen display 700 of FIG. 7 is generated, column 6, lines 48-52).

3-7. Regarding claim 23, Berger et al. further disclose wherein said design data publicizing processing unit including

information entry selecting means allowing a user to select either information entry in the form of a menu or transfer of said public design data and said editing program file (By clicking both buttons 606 and 608, the screen display 700 of FIG. 7 is generated, column 6, lines 48-52).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2128

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8, 10, 13-16, 19-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Patent 6,414,693 B1 issued July 2, 2002, and filed October 12, 1999, in view of Suda et al., U.S. Patent 6,279,000 B1 issued August 21, 2001, and filed December 29, 1997.

5-1. Regarding claims 5, 7, and 10, Berger et al. disclose a user's request reflecting design system in claim 1. Berger et al. fail to expressly disclose (1) said correction data receiving means including a data base for registering said correction data, and a received mail processing unit for receiving an electronic mail to which said correction data is attached and registering and storing said correction data in said data base; and (2) said received mail processing unit classifying said correction data attached and registering said correction data in said data base based on personal information of a user recited in said electronic mail. Nevertheless, Berger et al. do suggest the database is organized so that each unique user of the service is defined as an 'entity' 200 (Berger, column 4, lines 1-5) and the customized bag order can be associated with a given client and confirmed by return e-mail (Berger, column 8, lines 2-16).

Suda et al. disclose an information processing apparatus that can reduce the operating load placed on a user when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40). When electronic mail is received, the content of the electronic mail is analyzed. An item concerning a schedule is extracted from the analysis results and stored as a user's schedule in a database employed for the storage of schedule data (Suda, Abstract). In other words, by analyzing the received electronic mail, specific items (e.g., concerning a

Art Unit: 2128

schedule) are extracted, classified, registered, and stored (e.g., stored as a user's schedule in a database).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Suda et al. to obtain the invention as specified in claims 5, 7, and 10 because by incorporating Suda's information processing apparatus the operating load placed on a designer would be reduced when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40).

5-2. Regarding claim 6, the system claim recites a subset of the combined system limitations of claims 1 and 5 and is unpatentable using the same analysis of claims 1 and 5.

5-3. Regarding claim 8, the system claim recites a subset of the combined system limitations of claims 1 and 7 and is unpatentable using the same analysis of claims 1 and 7.

5-4. Regarding claims 13 and 15, Berger et al. disclose a user's request reflecting design method in claim 11. Berger et al. fail to expressly disclose (1) said correction data receiving step including the step of receiving an electronic mail to which said correction data is attached and registering said correction data in a data base for registering said correction data; and (2) classifying said correction data attached and registering said correction data in a data base based on personal information of a user recited in said electronic mail. Nevertheless, Berger et al. do suggest the database is organized so that each unique user of the service is defined as an 'entity' 200 (Berger, column 4, lines 1-5) and the customized bag order can be associated with a given client and confirmed by return e-mail (Berger, column 8, lines 2-16).

Suda et al. disclose an information processing apparatus that can reduce the operating load placed on a user when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40). When electronic mail is received, the content of the electronic mail is analyzed. An item concerning a schedule is extracted from the analysis results and stored as a user's schedule in a database employed for the storage of schedule data (Suda, Abstract). In other words, by analyzing the received electronic mail, specific items (e.g., concerning a schedule) are extracted, classified, registered, and stored (e.g., stored as a user's schedule in a database).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Suda et al. to obtain the invention as specified in claims 13 and 15 because by incorporating Suda's information processing apparatus the operating load placed on a designer would be reduced when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40).

5-5. Regarding claim 14, the method claim recites a subset of the combined method limitations of claims 11 and 13 and is unpatentable using the same analysis of claims 11 and 13.

5-6. Regarding claim 16, the method claim recites a subset of the combined method limitations of claims 11 and 15 and is unpatentable using the same analysis of claims 11 and 15.

5-7. Regarding claims 19 and 21, Berger et al. disclose a server of a user's request reflecting design system in claim 17. Berger et al. fail to expressly disclose (1) said correction data receiving means including a data base for registering said correction data, and a received mail processing unit for receiving an electronic mail to which said correction data is attached and

Art Unit: 2128

registering and storing said correction data in said data base; and (2) said received mail processing unit classifying said correction data attached and registering said correction data in said data base based on personal information of a user recited in said electronic mail.

Nevertheless, Berger et al. do suggest the database is organized so that each unique user of the service is defined as an 'entity' 200 (Berger, column 4, lines 1-5) and the customized bag order can be associated with a given client and confirmed by return e-mail (Berger, column 8, lines 2-16).

Suda et al. disclose an information processing apparatus that can reduce the operating load placed on a user when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40). When electronic mail is received, the content of the electronic mail is analyzed. An item concerning a schedule is extracted from the analysis results and stored as a user's schedule in a database employed for the storage of schedule data (Suda, Abstract). In other words, by analyzing the received electronic mail, specific items (e.g., concerning a schedule) are extracted, classified, registered, and stored (e.g., stored as a user's schedule in a database).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Berger et al. to incorporate the teachings of Suda et al. to obtain the invention as specified in claims 19 and 21 because by incorporating Suda's information processing apparatus the operating load placed on a designer would be reduced when effective information is to be extracted from information that is input (Suda, column 1, lines 36-40).

Art Unit: 2128

5-8. Regarding claim 20, the server claim recites a subset of the combined server limitations of claims 17 and 19 and is unpatentable using the same analysis of claims 17 and 19.

5-9. Regarding claim 22, the server claim recites a subset of the combined server limitations of claims 17 and 21 and is unpatentable using the same analysis of claims 17 and 21.

5-10. Regarding claim 24, Suda et al. further disclose wherein

an electronic mail, to which said correction data is attached, is received at said correction data receiving means, said electronic mail comprising personal information of the user (For example, user's electronic mail address is personal information).

5-11. Regarding claim 25, Suda et al. further disclose comprising:

receiving an electronic mail to which said correction data is attached, said electronic mail comprising personal information of the user (For example, user's electronic mail address is personal information).

5-12. Regarding claim 26, Suda et al. further disclose:

an electronic mail, to which said correction data is attached, is received at said correction data receiving means, said electronic mail comprising personal information of the user (For example, user's electronic mail address is personal information).

Applicant's Arguments

6. Applicant argues the following:

6-1. Rejection Under 35 U.S.C. § 102(b)

(1) "There is no mention in Matsuzaki of transferring an editing program file to a terminal" (page 14, paragraph 2, Amendment).

6-2. Rejection Under 35 U.S.C. § 103(a)

(2) "Suda does not remedy the deficiencies of Matsuzaki" (page 16, paragraph 1, Amendment).

Response to Arguments

7. Applicant's arguments (1) and (2) with respect to claims 1-26 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2128

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day

March 15, 2006

H.D.

Thayphan
Thai Phan
Patent Examiner